



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: Kazuo HAYASHI  
Application No.: 10/612,289  
Filed: July 3, 2003  
For: TEST APPARATUS, MOBILE TERMINAL APPARATUS, TEST METHOD

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner of Patents  
Washington, DC 20231

Dear Sir:

Pursuant to Rules 56 and 99, Applicants hereby call the attention of the Patent Office to the art listed on the attached Form PTO 1449. JP '694 and JP '897 were cited in a Japanese Office Action dated January 20, 2004 (English translation attached). WO '380 corresponds to JP '694 and WO '259 corresponds to JP '897.

Applicants present this art so that the Patent Office may, in the first instance, determine any relevancy thereof to the presently claimed invention, see Beckman Instruments, Inc. v. Chemtronics, Inc., 439 F.2d 1369, 1380, 165 USPQ 355, 364 (5th Cir. 1970). Also see Patent Office Rules 104 and 106. Applicants respectfully request that this art be expressly considered during the prosecution of this application and made of record herein and appear among the "References Cited" on any patent to issue herefrom.

Respectfully submitted,

Reg # 31,659

Date: April 21, 2004

James E. Ledbetter  
Registration No. 28,732

JEL/spp

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**FORM PTO-1449**  
(Rev. 4/92)

U.S. Department of Commerce  
Patent and Trademark Office

ATTY. DOCKET NO.

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SERIAL NO.

**10/612,289**

# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use several sheets if necessary)

APPLICANT

**Kazuo HAYASHI**

FILING DATE

**July 3, 2003**

**GROUP**

## Unassigned

U.S. PATENT DOCUMENTS

[illegible]

## FOREIGN PATENT DOCUMENTS

[illegible]

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**


**EXAMINER**

**DATE CONSIDERED**

**EXAMINER:** Initial if citation is considered, draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

(Form PTO-1449 [6-4])

(English Translation)



## **NOTICE OF REASON FOR REJECTION**

Dispatch Date : January 20, 2004

Japanese Patent Application Number : No. 2003-298006

Drafting Date : January 16, 2004

Examiner of Patent Office : Susumu TAKAGI

Attorney : Kimihito WASHIDA

Applied Provision : Section 29(2)

This application should be refused for the reason mentioned below. If the applicant has any argument against the reason, such argument should be submitted within 60 days from the date on which this notification was dispatched.

### **REASON(S)**

The invention(s) in the claim(s) listed below of the subject application should not be granted a patent under the provision of Patent Law Section 29(2) since it could have easily been made by persons who have common knowledge in the technical field to which the invention(s) pertains, on the basis of invention(s) described in the publication(s) listed below which was distributed, or invention(s) made accessible to public through electric telecommunication line, in Japan or foreign countries prior to the filing of the subject application.

Reference [Refer to the list of Cited Reference(s).]

It is recognized that the invention according to claims 1 through 5 are as stated in Scope of Claims 1 through 5.

1. Claim(s) 1-3

Cited Reference 1 (specifically, refer to descriptions pertaining to FIG 3 through FIG 5) discloses “Method for Testing the Functioning of a Radio Apparatus, and a Mobile Station” where a testing apparatus starts testing by sending a special test message in an RLC data block, and the operation of the mobile station depends on the instructions given by the testing apparatus for performing the testing.

Compared with Cited Reference 1, the invention according to the claims differs from the citation in that the invention comprises a loop-back section, and performs a radio transmission characteristics test.

Studying the difference here, it is recognized that the reason why “the transmission of a signaling signal is suspended” is that the signaling signal inserted periodically is not necessary for the radio characteristic test. That is, it is a matter of arbitrary design for a person skilled in the art to omit the transmission of a signal which is not necessary depending on test item. For example, also in the descriptions of Cited Reference 1 (specifically, refer to Paragraphs [0041] through [0049]), it is described therein that the operation of a mobile station under testing is dictated by instructions given from a testing apparatus performing the test, and that it is possible for the testing apparatus to transmit various commands to the mobile station in order not to require participation in any traffic of upper protocol level, and therefore, it is implied therein that no transmission / reception of any signal unnecessary for testing is done.

In addition, it is also a matter of arbitrary design for a person skilled in the art to comprise a loop-back section, and perform a radio transmission characteristics test, and there is not any noticeable effect therein by adopting such a design.

For example, the invention of “Mobile Apparatus Using Loop-back Module” is disclosed in Cited Reference 2 (specifically, refer to descriptions pertaining to FIG 2 through FIG 4), wherein, when performing a test by using a loop-back module,

transmission is done with control data and signaling data inserted therein as audio data, and the control data and the signaling data is de-multiplexed from the audio data through the decoding of a received signal, thereby performing a function test such as power control, and so on.

2. Claim(s)                      4 and 5

It is a matter of arbitrary design for a person skilled in the art to conduct communication with a wireless terminal by having a wireless connection via a wireless interface, or by having a wired connection via an external interface, and there is not any noticeable effect therein by adopting such a design.

If any new reason for refusal is found in future, a further notice will be issued.

Cited Reference(s)

1. Published Japanese Translations of PCT International Publication No. 2002-538694
2. Published Japanese Translations of PCT International Publication No. 2003-511897